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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,223	12/05/2003	Gregory T. Huber	S9025.0331	2462

32172 7590 12/03/2007

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NEW YORK, NY 10036-2714

EXAMINER
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MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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12/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/730,223	Applicant(s) HUBER ET AL.	
	Examiner Sanza L. McClendon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 16-22 and 24-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 16-22, and 24-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Please note the examiner record has changed. The new examiner is Sanza McClendon.

#### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114 was filed in this application on 9/21/2007, after appeal to the Board of Patent Appeals and Interferences. Therefore, the appeal has been withdrawn pursuant to 37 CFR 1.114. See MPAR 1215.01.

#### ***Response to Amendment***

3. In response to the Amendment received on September 21, 2007, the examiner has carefully considered the amendments. The examiner acknowledges the addition of claims 37-41.

#### ***Response to Arguments***

4. Applicant's arguments filed September 21, 2007 have been fully considered but they are not fully persuasive. However, the rejection of claims 1-15 and 30-36 under 35 USC 103(a) as being unpatentable over Johnson et al (US 7,056,962) has been withdrawn.

5. The rejection of claims 1-10, 16-22 and 24-36 under 35 USC 103(a) as being obvious over GB 1424517 (herein after, Topham et al) in view of GB 1108261 (herein after, Frakas et al) still stands, wherein claims 37-41 will be added. Applicant appears to be relying on the amendment to the claims to overcome the rejection, as well as, trying to establish that Frakas et al does not remedy the deficiencies of Topham et al, i.e., the R moiety of the dispersant. Applicant appears to be arguing there are too many possibilities for choosing an R group from Frakas et al to arrive at the instant claims when combined with Topham et al.

6. However, the examiner respectfully disagrees. Topham et al teaches a pigment dispersion comprising a colored dispersant of the formula  $D-(Z-R)_n$ , wherein D corresponds to applicants instant A chromophore, Z is a divalent bridging groups, R is a polymeric unit and n is 1-8. The bridging group Z can be a moiety selected from the five as found on page 1, wherein out of the five exactly 3 meet the requirements of the instant claims, i.e., containing N and at least one of S and O. Thus there appears to be a 60% chance of an ordinarily skilled artisan for selected a grouping that reads on the instant claims. Topham et al further discloses that the R residue preferably contains a polymer chain which is solvatable as defined by GB 1108261 (i.e., Frakas et al), as well as, teaching the preferable medium for the colored dispersant is an organic

hydrocarbon solvent, preferably being predominantly aliphatic petroleums (such as, butane, ethane and propane). Frakas et al set forth that when the organic medium is non-polar (i.e., a liquid aliphatic hydrocarbon), the polymer may be of unsaturated hydrocarbons such as ethylene, propylene, isobutylene and isoprene. Therefore the examiner deems that the listing of possibilities is not as exhaustive as applicant appears to be seems to be relying on. Topham et al teaches that said polymeric groups (R ) is one that is solvatable in the solvent medium, wherein said solvent medium is a aliphatic hydrocarbon medium and Frakas et al teaches when using a aliphatic organic solvent medium the polymeric groups (R ) can be those as listed above and found on page 2, lines 56-58. Therefore, the examiner deems the instant invention is envisioned within the combined teachings of Topham et al and Frakas et al without the possibility of have to pick and choose from a huge number of possibilities as supposed by applicant. Thus the rejection of the claims as written in the office action from 7/09/2007 and 3/22/07 still stand.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. Claims 1-10, 16-22, and 24-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Topham et al (GB 1424517) in view of Frakas et al (GB 1108261).
9. The discussion of the disclosed references Topham et al in view of Frakas et al can be found in office actions dated 3/22/07 and 7/09/07 are herein incorporated by reference.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Sandra McClendon

Examiner

Art Unit 1796

SMc